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09/761,506	01/16/2001	Timothy K. Doherty	BGE-1	5918

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/761,506

Applicant(s)

DOHERTY ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-37 are pending in the instant application.

Drawings

The replacement drawing sheets were received on February 18, 2004. The Examiner accepts these drawings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-26, 32-34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoyle U.S. Patent No. 6,141,010.

Referring to claim 1. Hoyle discloses an Internet advertising system comprising:

- A multimedia presentation comprising at least one component selected from a group consisting of graphics, animated graphics and full-motion video, the selected component of the multimedia presentation containing an embedded placeholder (Fig. 5 and Fig. 5a);

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- A set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (abstract);
- Means for identifying at least one demographic characteristic of a user (column 2, lines 22-44);
- Means for selecting one advertisement from the set of advertisements, the selector means including a comparison of the user's at least one demographic characteristic with the at least one demographic indicator of each advertisement to select the most relevant advertisement for the user (column 5, line 6 to column 6, line 5);
- Means for inserting the selected advertisement into the embedded placeholder of the multimedia presentation, the inserter means creating a seamless advertisement dynamically contained in the multimedia (column 5, line 6 to column 6, line 5, Fig. 5 and Fig. 5a);
- Presentation and targeted to the user's demographic characteristics (column 5, line 6 to column 6, line 5); and
- Means for delivering the multimedia presentation to the user (column 5, line 6 to column 6, line 5).

Referring to claim 2. Hoyle further discloses a system comprising a hyperlink in the advertisement contained in the multimedia presentation (column 14, line 59 to column 5, line 28).

Referring to claim 3. Hoyle further discloses a system wherein the hyperlink in the advertisement is a hyperlink to an advertiser's website (column 14, line 59 to column 5, line 28).

Referring to claim 4. Hoyle further discloses a system wherein the multimedia presentation is an animation (column 3, lines 30-67).

Referring to claim 5. Hoyle further discloses a system wherein the animation is created using Flash (column 3, lines 30-67).

Referring to claim 6. Hoyle further discloses a system wherein the Flash animation is an original presentation (column 3, lines 30-67).

Referring to claim 7. Hoyle further discloses a system wherein the Flash animation is a pre-existing presentation and the embedded placeholder is then added to the pre-existing presentation (column 3, lines 30-67).

Referring to claim 10. Hoyle further discloses a system wherein the identifier means includes cookies generated by an Internet browser of the user (column 17, lines 27-45).

Referring to claim 11. Hoyle further discloses a system wherein the identifier means includes a survey completed by the user (Fig. 8, "Send Form to User").

Referring to claim 12. Hoyle further discloses a system wherein the inserter means is a computer program (claim 16).

Referring to claim 13. Hoyle further discloses a system wherein the computer program is Generator (claim 16).

Referring to claim 14. Hoyle further discloses a system wherein the computer program is stored on a first server and the multimedia presentation containing the embedded placeholder is also stored on the first server (claim 16).

Referring to claim 15. Hoyle further discloses a system wherein the computer program is stored on a first server and the multimedia presentation containing the embedded placeholder is stored on a second server (claim 16).

Referring to claim 16. Hoyle further discloses a system wherein the delivery means is an Internet connection between a first server storing the multimedia presentation containing the embedded placeholder and a computer operated by the user (Fig. 4)

Referring to claim 17. Hoyle further discloses a system comprising a syndication network (Fig. 4).

Referring to claim 18. Hoyle further discloses a system wherein the syndicated network collects the multimedia presentation and the selected advertisement, and the syndication network delivers the multimedia presentation containing the selected advertisement to the user's computer (column 5, line 6 to column 6, line 5).

Referring to claim 19. Hoyle further discloses a system wherein the syndicated network collects the multimedia presentation and the selected advertisement separate from one another, and a server in the syndication network inserts the selected advertisement into the multimedia presentation (column 5, line 6 to column 6, line 5).

Referring to claim 20. Hoyle further discloses a system wherein the syndicated network collects the multimedia presentation having the selected advertisement inserted

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therein previous to entering the syndication network (column 5, line 6 to column 6, line 5).

Referring to claim 21. Hoyle further discloses a system wherein the syndicated network collects information relating to the identifier means from the user's computer and delivers the identifier information to the selector means (column 5, line 6 to column 6, line 5).

Referring to claim 22. Hoyle further discloses a system that comprises a media buyer providing at least a portion of the set of advertisements (Fig. 4).

Referring to claim 23. Hoyle further discloses a system wherein the media buyer receives information relating to the identifier means from the user's computer (column 5, line 6 to column 6, line 5).

Referring to claim 24. Hoyle further discloses a system wherein the identifier information from the syndication network is further delivered to a media buyer (column 5, line 6 to column 6, line 5).

Referring to claim 25. Hoyle further discloses a system wherein the identifier information is delivered from the syndication network to the media buyer to the selector means (column 5, line 6 to column 6, line 5).

Referring to claim 26. Hoyle further discloses a system wherein the identifier information is delivered from the syndication network to the media buyer and the identifier information is also delivered from the syndication network to the selector means (column 5, line 6 to column 6, line 5).

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Referring to claim 32. Claim 32 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 33. Hoyle further discloses a system wherein the selector randomly selects the advertisement (column 5, line 6 to column 6, line 5).

Referring to claim 34. Hoyle further discloses a system wherein the seamless advertisement is dynamically contained in the multimedia presentation (abstract).

Referring to claim 37. Claim 37 is rejected under the same rationale as set forth above in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9, 27-31 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S. Patent No. 6,141,010 in view of Gupta U.S. Patent No. 6,487,538.

Referring to claim 8. Hoyle discloses a system according to claim 1 as indicated supra. Hoyle does not expressly disclose the system wherein the multimedia presentation includes at least two embedded placeholders. Gupta discloses the system wherein the multimedia presentation includes at least two embedded placeholders (Gupta: column 11, lines 43-65). At the time the invention was made, it would have

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been obvious to a person of ordinary skill in the art to have modified the system of Hoyle to have included the limitations of Gupta as discussed above because it is desirable for advertisements to target specific audiences and persons that may be interested in the specific goods or services being advertised (Gupta: column 1, lines 21-34).

Referring to claim 9. Hoyle discloses a system according to claim 8 as indicated supra. Hoyle does not expressly disclose the system comprising multiple sets of advertisements, each set of advertisements corresponding to one of the at least two embedded placeholders. Gupta discloses the system comprising multiple sets of advertisements, each set of advertisements corresponding to one of the at least two embedded placeholders (column 11, lines 43-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Hoyle to have included the limitations of Gupta as discussed above because it is desirable for advertisements to target specific audiences and persons that may be interested in the specific goods or services being advertised (Gupta: column 1, lines 21-34).

Referring to claims 27-30. Hoyle discloses a system according to claim 8 as indicated supra. Hoyle does not expressly disclose the system comprising:

- An advertisement charge to the sponsor of the selected advertisement delivered in the multi-media presentation wherein the charge is paid to an owner of the multimedia presentation;

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- Is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisements; or
- Is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the inserted advertisement, and an owner of the delivery means for providing the multimedia presentation to the user.

Gupta discloses the system comprising:

- An advertisement charge to the sponsor of the selected advertisement delivered in the multi-media presentation wherein the charge is paid to an owner of the multimedia presentation (Gupta: column 4, lines 26-37);
- Is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement (Gupta: column 4, lines 26-37); or
- Is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the inserted advertisement, and an owner of the delivery means for providing the multimedia presentation to the user (Gupta: column 4, lines 26-37).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Hoyle to have included the limitations of Gupta as discussed above so advertisements would be able to appear on web sites that do not normally attract advertisers (Gupta: column 6, lines 10-23).

Referring to claim 31. Hoyle further discloses the system wherein the delivery means is a syndication network (Fig. 4).

Referring to claims 35 and 36. Claims 35 and 36 are rejected under the same rationale as set forth above in claims 1-34.

Response to Arguments

Applicant's arguments concerning claims 1-33 and 36-37 filed February 18, 2004 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 34-35 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant amended claims 1, 32 and 37 to call for a multimedia presentation comprising at least one component selected from a group consisting of graphics, animated graphics and full-motion video.

The Examiner notes, Fig. 7 of Hoyle discloses a multimedia presentation comprising at least a graphic (i.e. Banner01.gif). Gif's are well known in the art to stand for Graphics Interchange Format. Gif is a standard for digitised images compressed with the LZW algorithm, defined in 1987 by CompuServe (CIS).

Furthermore, the Applicant amended claims 1, 32 and 37 to recite a Markush grouping. Markush groupings are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. In the instant application claim 1, 32 and 37 do not overcome the cited prior art because at least one aspect of the Markush grouping was located in the prior art.

The Applicant stats, "Claims 2-7, 10-26 and 33, which directly depends from independent claim 32, is believed to be in condition for allowance for at least the above-

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identified reasons. Accordingly, allowance of claims 2-7, 10-26 and 33 is respectfully requested."

The Examiner notes, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

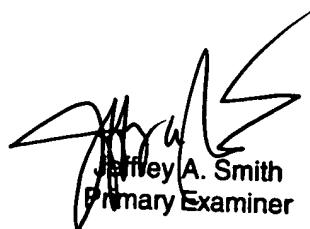
Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

March 4, 2004



Jeffrey A. Smith
Primary Examiner